

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated March 19, 2004, indicated that claims 9, 12-14 and 24 are objected to as being dependent on a rejected base claim but would be allowable if rewritten; and claims 1-8, 10, 11, 15-23 and 25-35 are rejected under 35 U.S.C. § 102(e) over *Sherman et al.* (U.S. Patent No. 6,647,409).

Applicant respectfully traverses the Section 102(e) rejection and submits that the teaching in the cited '409 reference is far removed from the present invention that there are no issues of patentability relative thereto. To the extent that Section 102(e) has been raised in the Office Action, Applicant respectfully submits that the '409 reference has been misinterpreted.

Before addressing this interpretation issue, the objections to claims 14 and 24 are overcome by the above amendment to claims 14 and 24. There being no patentability issues raised in the Office Action with respect to these claims (14 and 24), Applicant has amended claim 14 to incorporate its underlying claims 1 and 11, and has amended claim 24 to incorporate its underlying claims 17, 21 and 23. These claims should now be in allowable form and Applicant requests that the objection to these claims be removed.

Applicant also appreciates the indication of allowability for claims 9, 12 and 13, and believes the claims to be in condition for allowance (without any amendments) in view of the following remarks.

Regarding the Section 102(e) rejection, Applicant respectfully traverses and submits that there is no substantive relationship between the '409 reference and the claimed invention and that a *prima facie* case of anticipation has not been presented. A *prima facie* case of anticipation of a claim requires a proper presentation of evidence that would allege correspondence between the cited teaching (e.g., from the '409 reference) and each limitation in the claims. However, in connection with the Section 102(e) rejection, only general assertions have been made and these assertions are based on citations to the '409 reference that are unrelated to the claimed invention and thus, fail to correspond. For

example, each rejected claim is directed to a condition in which reference information may be locally stored at the wireless terminal. While the Office Action generally provides citations to the ‘409 reference, none of the citations relate to any storage of the desired reference information locally at the wireless terminal, as claimed. Moreover, after further review of the ‘409 reference, the ‘409 reference teaches that the requested email data is not stored locally. Figure 3 and the corresponding discussion at column 6, lines 12-39, teach that the handheld PC uses modules to access emails stored at the email servers. The ‘409 reference would therefore not initially have the desired information stored locally and must use the modules to access any of the ‘409 reference’s desired information. Without a presentation of correspondence to each of the claimed limitations, the Office Action fails to present a *prima facie* case of rejection and the Section 102(e) rejection must fail. Applicant accordingly requests that the rejection be withdrawn.

Moreover, the Office Action fails to explain how the ‘409 reference’s emails are being interpreted as corresponding to the claimed “reference information.” The instant Specification gives examples of the claimed reference information: dictionary definitions, language translations, and telephone directory information, etc. The Office Action acknowledges at page 4 that the ‘409 reference fails to teach these examples and further fails to identify how the ‘409 reference would correspond to the claimed invention in view of this deficiency. If the rejection assumes such correspondence, the Office Action fails to explain the correspondence in connection with the attempt to present a *prima facie* case under Section 102(e).

With particular respect to claims 5-8, 10, 11, 15 and 16, the Office Action acknowledges that the ‘409 reference fails to teach limitations of each of the claims and generally dismisses the limitations without addressing them. This failure to address the claimed invention “as a whole” is improper. A Section 102 rejection must show correspondence to each of the claimed limitations. Each of the limitations claimed are part of the instant invention and must be addressed by the Office Action. If the Examiner’s comments in this regard are intended to suggest that these claim limitations are well-known, pursuant to MPEP § 2144.03, Applicant requests evidence in support of such an assertion. Moreover, the Office Action cannot ignore such specific claim limitations when the cited

reference fails to recognize the problems addressed by the instant invention. *See MPEP § 2141.02.* Without an allegation of correspondence, the rejection cannot stand and Applicant requests that the rejection be withdrawn.

Regarding claims 17-23 and 25 -35, the Office Action fails to address any of the limitations unique to these claims; and therefore, the rejection is improper and must be withdrawn. *See 37 C.F.R. § 1.104(a)(2) and 35 U.S.C. § 132.* For example, no correspondence is alleged to the limitations of claim 31 directed to the wireless terminal being a wireless telephone. The Office Action fails to satisfy these requirements as the Office Action is silent as to any reasons for the rejection of these unique claim limitations. Applicant accordingly requests that the rejection be withdrawn.

Applicant has amended independent claims 1 and 32 to better characterize the claimed invention. The amendments do not alter the scope of the claims as the now-claimed subject matter was implicit in the original claims and were not made for any patentability reasons. The claims, as amended, are believed to be patentable over the cited art for the reasons state above.

Applicant has added new claims 36-39 to further characterize the claimed invention. The amendment does not introduce new matter as supported by page 7, lines 9-12, of the Specification. Applicant believes new claims 36-39 are patentable over the cited prior art for the reasons presented above.

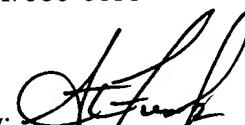
Please charge deposit account 50-0996 (NOKV.007PA) in the amount of \$244.00 for the two new independent claims and the four new claims in excess of twenty. Additionally, authorization is given to charge any additional fees or credit any overpayments that may be deemed necessary to the above-identified deposit account number.

In view of the above discussion, Applicant believes that the rejections have been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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Date: June 21, 2004

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